

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action mailed June 10, 2004 ("Final Office Action"), and the Advisory Action mailed September 7, 2004 ("Advisory Action"). The comments made herein address the PTO's Remarks in both the Final Office Action and the Advisory Action. Applicant respectfully requests reconsideration and favorable action of all pending claims in view of the following.

Section 102 and 103 Rejections

Claims 1-2, 4-10, 12-15, 17-22, 24-28, and 30-37 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Printed Publication No. 2002/0179720, listing *Liva* as the first named inventor ("*Liva*"), and Claims 3, 11, 16, 23, and 29 35 were rejected under U.S.C. 103(a) as being unpatentable over *Liva*, in further view of by U.S. Printed Publication No. 2002/0112940, listing Heilmann as the first named inventor ("*Heilmann*"). Because the earliest claimed priority date (May 30, 2001) of *Liva* predates the filing date of the present Application (July 12, 2001) by only one and a half months, Applicant herewith submits a Declaration under 37 C.F.R. §1.131, which includes evidentiary documentation ("Declaration"). This Declaration clearly establishes (1) that the invention was conceived prior to May 30, 2001 and (2) that those involved with the application were reasonably diligent between May 30, 2001 and July 12, 2001 in finalizing paperwork to file the Application, as described below.

A draft of the present Application, substantially similar to the Application as filed, was prepared and transmitted to the inventor for review prior to May 30, 2001. See Declaration, Paragraph 2. As evidentiary support of the content of this draft Application, the Declaration includes a copy of the draft drawings as they existed prior to May 30, 2001 attached as part of the application transmitted to the inventor for review. See Declaration, Exhibit A. A comparison of these drawings to the drawings that were filed with the application confirms that conception occurred prior to *Liva*'s earliest claimed priority date .

Applicant, Applicant's attorney and others involved with the application were reasonably diligent between *Liva*'s earliest claimed priority date of May 30, 2001, and the Application's filing date of July 12, 2001. During this time, Applicant, Applicant's attorney and others involved with the application finalized the paper work in preparation for filing. See Declaration, Paragraph 3. Such finalizing of the paperwork, among other items, included making minor edits

to the application (*See, e.g.*, a comparison of the draft drawings in Exhibit A of the Declaration and the drawings of the Application as filed in the File Wrapper); preparing patent application transmittal paperwork (*See* paperwork filed in application in the File Wrapper); transmitting a final version of the application to the inventor for execution (*See* July 2, 2001, letter in Exhibit A of the Declaration); and signing the Application's Declaration and Application's Assignment (*See* the July 10, 2001, execution date of both documents in the File Wrapper). The culmination of this preparation resulted in the filing of the Application on July 12, 2001.

With this Declaration, Applicant respectfully submits that *Liva* is no longer appropriate as *prior art* to the present Application. Accordingly, as all of the previous rejections of Claims 1-37 have relied on *Liva*, Applicant respectfully submits that Claims 1-37 are allowable.

Assuming *arguendo* that the PTO maintains *Liva* as prior art to the present Application, Applicant respectfully submits that the PTO has failed to establish that the references (including *Liva*) disclose expressly or inherently, each and every element of the invention as defined by the claims.

Liva has an actual filing date after the filing date of the Application. Therefore, in utilizing *Liva* as a reference, Applicant submits that the PTO must (1) establish the rejection based on the disclosure of *Liva*, and (2) include a showing of support in the provisional application to which *Liva* claims priority. A rejection based solely on the provisional application would clearly be improper because that application does not qualify as prior art under 35. U.S.C. Section 102, as would a rejection based on any portion of *Liva* that was not also supported in the provisional application. With regards to Independent Claim 1, Applicant submits that the PTO has failed to establish that *Liva*, itself, discloses at the least following limitation:

“coupling the input node of the first card to the input node of the second card to provide redundancy for the first card by connecting the input node of the first card to the associated output node of the first card” (emphasis added)

In both the Final Office Action and the Non-Final Office Action, the PTO indicated the following:

“Regarding Claim 1, *Liva* discloses...connecting the input node of the first card, thereby coupling the input node of the first card to the input node of the second card to provide redundancy (e.g., paragraph [0023])”

With this language, it is clear that the PTO has not established “connecting the input node of the first card to the associated output node of the first card.” The PTO’s only response to Applicant’s previous arguments concerning this limitation occurs in the “Response to Arguments” section of the Final Office Action, in which the PTO stated that the provisional application from which *Liva* claims priority discloses this limitation. Although this is incorrect as described below, the above claim limitation is not disclosed in *Liva*, itself, and the PTO has failed to identify such a limitation in *Liva*, which would be required for a rejection.¹ The systems of Figures 4 and 5 of *Liva*, on which the previous Office Actions rely, involve decoupling input and output nodes of line cards from respective connections and coupling of these nodes to other connections – but not to each other. For at least these reasons Claim 1 is allowable, as are the claims depending therefrom. Reconsideration and favorable action are requested.

Assuming *arguendo* that *Liva* disclosed the above limitation, Applicant submits that such a limitation is not supported in the provisional application on which *Liva* relies. In asserting that the provisional application teaches this limitation the Office Action refers primarily to the third figure in the Appendix, but Applicant believes the PTO misunderstood the labeling of the boxes in that figure. In particular, the circuitry shown in the boxes labeled “Line Card #1” and “Line Card #2” do not correspond to circuitry on a line card for which redundancy is provided. Rather its circuitry on an I/O card that may be connected to line cards through the “Local RF Out” and “Local RF In” ports; and the provisional application clearly fails to show connecting the “Local RF Out” and “Local RF In” ports to each other to provide redundancy. This is confirmed on the first and second pages of the Appendix where it states “[a] number of these can be deployed on **the I/O card associated with a PBComm Line Card** as follows (one each downstream and upstream shown): “Local input or output refers to signals to/from the **associated Line Card**. ‘B/U’ refers to a set of buses used for the backup function. ‘RF In’ and ‘RF Out’ refer to the rear panel connectors providing connections to/from the cable plant.” **Thus, the labels “Line Card #1” and “Line Card #2” do not refer to line cards having the given circuitry, but rather that the illustrated circuitry may be connected to “Line Card #1” and “Line Card #2.”** Thus, the provisional application does not show “coupling the input node of the first card to the

¹ The Final Office Action states “[e]xaminer has based the response on disclosure from the provisional Application; the parallels to the publication relied upon and cited in the rejection maintained above are clear,” but this is incorrect. The parallels are not clear. Rather, the disclosure of *Liva* and the provisional application differ. Figures 4 and 5 of *Liva*, on which the Office Actions rely differ significantly from the Appendix of the provisional application.

input node of the second card to provide redundancy for the first card by connecting the input node of the first card to the associated output node of the first card." (emphasis added). For at least this additional reason, Claim 1 is allowable. Reconsideration and favorable action is requested.

The remaining independent Claims 14, 26, and 35 are allowable for analogous reasons. As depending from an allowable independent claim, all pending dependent claims are also allowable. Reconsideration and favorable action are requested.

Claims 35 through 37 are also allowable because the Final Office Action has failed to make a *prima facie* showing of equivalence between the asserted element and the "means for selectively connecting" and the "means for connecting" claimed in Claim 35, as required by the Manual of Patent Examining Procedure. See M.P.E.P. Section 2183. That provision requires the PTO to "provide an explanation and a rationale in the Office Action as to why the [asserted prior art element] is an equivalent [of the corresponding element in the specification]." In other words, the PTO cannot rely on simply asserting that the claimed function of a means plus function limitation is met, but must also establish a *prima facie* case of equivalence regarding the corresponding structure. The Final Office Action is completely silent in this regard, stating merely that "[r]egarding Claim 35, *Liva* discloses first and second cards and means for selectively connecting the input node of the first card to the output node of the first card and means for connecting the output node of the first card to the input node of the second card (e.g., Figure 5)." Additionally, the Advisory Action only states the following: "the 'means for selectively connecting' and the 'means for connecting' are clearly shown in the cited Figure." Thus, there is clearly not "an explanation and rationale in the Office Action as to why the prior art element is an equivalent" required by M.P.E.P. Section 2183. Rather, it appears the common PTO practice before *In re Donaldson* of rejecting means plus function claims without reference to determining whether the corresponding means are equivalent is being improperly applied here. As failing to comply with the requirements of the M.P.E.P., the rejection of Claims 35-37 is improper for this additional reason. Reconsideration and favorable action are requested.

CONCLUSION

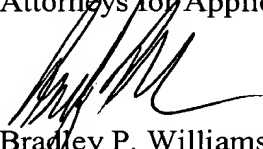
Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

If the Examiner feels that prosecution of the present Application may be advanced in any way by a telephone conference, the Examiner is invited to contact the undersigned attorney at 214-953-6447.

Applicant submits herewith a check in the amount of \$790.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). To the extent that any further fees are required, including petition fees, the Commissioner is hereby authorized to charge payment of any such fees, including, without limitation, any fees under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17, to Deposit Account No. 02-0384 of Baker Botts L.L.P. In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

Respectfully submitted,

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